

REMARKS

Applicants respectfully request reconsideration of the present application in view of the foregoing amendments and the following commentary.

I. Status of the Claims

Claims 1-55 were previously cancelled. Claims 56 and 63 have been amended with support in the original specification. See, for example, at page 17, first full paragraph; and at page 28, first and second full paragraphs.

It is acknowledged that the amendments to the claims are submitted after final rejection. However, because the amendments do not introduce new matter, they are necessitated by the Examiner's comments, they do not require any additional search, and they either place the application in condition for allowance or at least in better condition for appeal, entry thereof by the Examiner is respectfully requested. Upon entry, claims 56-64 will be pending.

II. Objection to the Specification

The objection to the specification is maintained because the status of the parent application Serial No. 09/720,533 has not been updated. Applicants submit herewith a supplemental ADS updating the status of the corresponding applications in the family. Accordingly, the stated basis for objection should be obviated.

III. Rejection of Claims under 35 U.S.C. § 101

Rejection of Claims 56-64 under 35 U.S.C. § 101 is maintained. Specifically, the Examiner contends that the specification does not specifically disclose that SEQ ID NO: 43 shares 99% identity with RELM-beta (or FIZZ) protein. Applicants respectfully traverse the rejection.

The specification describes that the nucleotide sequence, SEQ ID NO: 177, encoding the protein of SEQ ID NO: 43, is expressed in gastrointestinal tissues and relates to cancer and inflammation. See Table 3. Moreover, Table 4 discloses that the polynucleotide represented by SEQ ID NO: 177 was

isolated from diseased sigmoid colon tissues. Therefore, the disclosure of the original specification is consistent with and corroborated by the teachings of Hogan *et al.* (*J. Allergy Clin. Immunol.* 2006, 118:257-268; previously submitted) that RELM-beta protein is constitutively expressed in colon and that it has a central role in regulating colonic inflammation.

Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 101 because the utility of the claimed polynucleotide and polypeptide is disclosed in the original specification.

IV. Rejection of Claims under 35 U.S.C. § 112, first paragraph

The rejection of claims 56-64 under 35 U.S.C. § 112, first paragraph, is maintained on the ground that the claimed invention is not enabled due to its alleged lack of utility. In view of the discussion in section III of this response, the claimed invention possesses utility. Therefore, the rejection at issue should be withdrawn as well.

The rejection of claims 56, 59-61 and 63 under 35 U.S.C. § 112, first paragraph, is maintained. Specifically, the Examiner contends that the claims in question do not possess utility and that the claims in question do not recite any functional limitations to provide guidance for the alternations in the sequences of SEQ ID NOs: 43 and 177.

Nevertheless, the Examiner appears to agree that SEQ ID NOs:43 and 177 would be enabled if they possess utility. As discussed in the foregoing paragraphs, the claimed sequences possess utility and, therefore, are enabled.

The Examiner acknowledges that “the points argued by Applicants [that the specification provides a detailed description of the changes that can be made to the claimed sequences] were persuasive” (final Office Action, page 3, section 4B). Nevertheless, the Examiner requires that the claims recite the functional limitations. Applicants have amended claims 56 and 63 accordingly.

Because the stated grounds for rejection of claims 56, 59-61 and 63 for alleged lack of written description are identical to those for alleged lack of enablement, the foregoing amendments to the claims and discussions should obviate the rejection in question as well.

Accordingly, Applicants respectfully request withdrawal of the rejection under 35 U.S.C. § 112, first paragraph.

CONCLUSION

The present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested. The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check or credit card payment form being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicants hereby petition for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.

Respectfully submitted,

Date Aug 6, 2007

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